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Yuji Hiroshige

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EXAMINER

RIOJA, MELISSA A

ART UNIT

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1796

NOTIFICATION DATE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Response to Arguments

Applicant's amendment to Claim 11 has overcome the rejection of Claims 11 – 20 under 35 U.S.C 112, second paragraph. The rejection of Claims 11 – 20 under 35 U.S.C 112, second paragraph has been withdrawn.

All other arguments filed February 23, 2010 have been fully considered but they are not persuasive:

Applicant argues the instant claims are not obvious in view of Fischer et al., as Fischer et al. do not teach a foam sheet-forming composition comprising a heat polymerizable binder component in combination with the other claimed ingredients. However, the claims are directed to a polymerized foamed sheet and Fisher et al. in view of Yang et al. teach a foamed sheet formed from all the claimed ingredients. The polymerization of the (meth)acrylic monomers in the presence of the filler and foaming agent, instead of prior to their addition, is a product by process limitation.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695,698, 227 USPQ 964, 966 (Fed. Cir. 1985) (MPEP 2113) Once a product appearing substantially identical is found, the burden shifts to the applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993) (MPEP 2113) It is the Office's position that these products are substantially identical, as the original disclosure is silent with respect to a specific structure being caused by this

polymerization of the (meth)acrylic monomers in the presence of the filler and foaming agent.

Furthermore, while Fischer et al. does teach polymerizing the (meth)acrylic monomers prior to foaming, Fischer et al. teach the foam materials are desirably substantially free of low molecular weight polymers *other than* residuals resulting from polymerization of the PSA, i.e. partial polymers (Paragraphs 31). It is then submitted that the foam sheet taught by Fischer et al. may be prepared from a composition comprising using the claimed ingredients that comprises a partial polymer of a (meth)acrylic monomer.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA RIOJA whose telephone number is (571)270-3305. The examiner can normally be reached on Monday - Friday 7:00AM - 3:30PM E.S.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

/MAR/
March 1, 2010